



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,663	06/25/2003	Pierre Charneau	03495.0199-01	8007

22852 7590 10/10/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

HUMPHREY, LOUISE WANG ZHIYING

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,663	CHARNEAU ET AL.	
	Examiner	Art Unit	
	Louise Humphrey, Ph.D.	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-61 is/are pending in the application.
- 4a) Of the above claim(s) 52-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Final Office Action is in response to the After-Non-Final amendment filed on 13 July 2006. Claims 41-61 are pending, of which claims 52-61 are withdrawn from consideration and claims 41-51 are under final rejection.

Response to Arguments

Objections

The objection to claims 41 and 46 and specification is **withdrawn** in view of the Applicant's amendment.

Double Patenting

The Examiner notes with appreciation that Applicants have filed a terminal disclaimer. Applicant's arguments with respect to the statutory double patenting rejection of claims 41-51 over claims 1, 3, 4, 8-11, 14, 15, 22, and 23 of US Patent No. 6,682,907 have been fully considered and are persuasive. Therefore, the rejection has been replaced with nonstatutory obviousness-type double patenting. The nonstatutory double patenting rejection of claims 41-51 as being unpatentable over claims 1-4, 8-11, 14, 15, 22, and 23 of US Patent No. 6,682,907 will be withdrawn upon the granting of Applicants' terminal disclaimer.

The Examiner thanks the Applicants for pointing out that claims 1-35 of co-pending Application No. 10/313,038 have been cancelled. Claims 41-45 and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36, 40, 43, 44, and 69 of copending Application No.

Art Unit: 1648

10/313,038. The rejection is maintained.

Claim Rejections - 35 USC § 112

The rejection of claims 46-49 under 35 U.S.C. §112, second paragraph, as being indefinite **is withdrawn** in view of the amendment.

Claim Rejections - 35 USC § 102

The rejection of claims 41-51 under 35 U.S.C. §102(b) as being anticipated by Verma *et al.* (WO 97/12622) **is maintained**.

Applicants argue that the claimed invention requires “a polynucleotide” whereas Verma requires three vectors and that the description of the other plasmid vectors disclosed by the Verma, pCMVR8 and pHR'-Clucif, do not include the elements of the cPPT and CTS regions. Finally, Applicants argue that Verma does not disclose a vector “consisting of a polynucleotide” that includes the cPPT and CTS sequences.

Applicants' arguments have been fully considered and are not persuasive. The Verma reference teaches more than just the instant invention. Applicants are relying on irrelevant elements such as the two other vectors that do not include cPPT and CTS regions, to assert that the Verma reference does not anticipate the instant invention. However, Applicants' tangential argument does not address the relevant teaching in the Verma reference of a recombinant vector *comprising* a polynucleotide - the HIV *pol* vector- that does include cPPT and CTS regions. In response to Applicants' argument that Verma does not disclose a vector “consisting of” a polynucleotide, such closed claim language is not recited in the instant claims.

Art Unit: 1648

The rejection of claims 41-48, 50, and 51 under 35 U.S.C. §102(b) as being anticipated by Parolin *et al.* (1994) **is maintained**.

Applicants' arguments are directed to an irrelevant segment, *gag*, of the anticipatory plasmid taught in Parolin. Applicants argue that Parolin indicates that *gag* sequences increase the efficiency of gene transfer, while the addition of *pol* sequences to the *gag* sequences does not increase the efficiency any further. The efficiency of gene transfer is irrelevant to the instant invention. Applicants never responded to the fact that the Parolin plasmid *comprises* a *pol* polynucleotide, which naturally contains the cPPT and CTS regions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 1648

Contact Information

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise Humphrey, Ph.D. whose telephone number is 571-272-5543. The examiner can normally be reached on Mon-Fri, 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Jeffrey Parkin, Ph.D.
Primary Examiner
24 September 2006

Smith
9/24/2006